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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,310

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Bengt Hermansson

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EXAMINER

KRAUSE, JUSTIN MITCHELL

ART UNIT

PAPER NUMBER

3656

MAIL DATE

DELIVERY MODE

06/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,310	Applicant(s) HERMANSSON ET AL.	
	Examiner JUSTIN KRAUSE	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-19, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 20, 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because of the use of legal phraseology. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-19, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Reinecke (US Patent 4,519,266).

Reinecke discloses an arrangement for controlling gear positions in a car, comprising a console having a wall (38), and one or more sensors (9) arranged in

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connection to said wall, and further comprising a gear lever (1), constructed to move back and forth in a first and second principal direction essentially perpendicular to each other (see figure 3, for example), and a code device (6, 7,8) constructed to interact with said sensors, in which the code device is connected to the gear lever, which arrangement further comprises means for biasing the code device (15) in the direction of said console wall.

Regarding the limitation, "so that the code device is actuated to move in a first direction of movement upon motion of the gear lever in said first principal direction, and in a second direction of movement upon motion of the gear lever in said second principal direction, wherein the code device is pivotably secured adjacent to the gear lever", such a limitation is directed to how the device operates.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a

device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

MPEP 2114.

The device of Reinecke is capable of operating in the manner claimed, and in fact does operate in this manner. (see double H shift pattern, fig. 3)

Regarding claims 2 and 14, each sensor comprises a plurality of sub-sensors (see figure 5) disposed in a path.

Regarding claims 3 and 15, Reinecke discloses an arm (4) by which the code device is pivotably secured adjacent to the gear lever.

Regarding claims 4 and 16, the code device comprises a detection element (6) fixed at one end of the arm, the motion of the detection element upon motion of the code device being detectable by said one or more sensors.

Regarding claims 5 and 17, the detection element is pivotably secured at said one end of the arm.

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Regarding claims 7 and 19, the actuation of the code device upon motion of the gear lever is effected by the arrangement comprising means for making the motion of the code device in the said first direction of movement identical, regardless of whether the gear lever is guided forward or backward in its first principal direction. Reinecke is capable of functioning in this manner.

Regarding claims 10 and 22, the code device comprises a detection element (6), which is fixed at one end of the arm, the motion of the detection element upon motion of the code device being able to be detected by the said sensors.

Regarding claims 11 and 23, the detection element is pivotably secured at the said one end of the arm.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinecke.

Reinecke discloses an alternative embodiment where the pivot fastening of the detection element is articulated so that it allows the detection element always to be able to maintain essentially the same angle in relation to the console wall, regardless of the motions of the gear lever (see figure 19) to maintain contact between the magnetic sensors and the magnet (Col 4, lines 1-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Reinecke to include an articulated pivot to maintain contact between magnetic sensors and the magnet as taught by Reinecke.

Regarding claim 12, a spring (50), biases the code device toward the wall.

Allowable Subject Matter

Claims 8, 9, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed February 20, 2009 have been fully considered but they are not persuasive. Applicant argues the first embodiment of Reinecke does not disclose, "a code device constructed to interact with said one or more sensors wherein the code device is connected to the gear lever so that the code device moves in a first direction of movement upon motion of the gear lever in said first principal direction and in a second direction of movement upon motion of the gear lever in said second principal direction".

As is discussed in Reinecke, the arm (4) on which the code device is mounted is attached to the shift lever (col. 2, line 4), the shift pattern is a "double H" pattern (see fig 3), and the gear lever moves about the axis on a pair of gimbals to traverse the shift pattern (col. 1, lines 64-68). Thus, as the shift lever is moved, so is the code device, in a first and second direction, perpendicular to one another as the shift lever is moved through the shift pattern. Accordingly, the shift device disclosed by Reinecke satisfies the limitations claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN KRAUSE whose telephone number is (571)272-3012. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin Krause/
Examiner, Art Unit 3656
/Thomas R. Hannon/
Primary Examiner, Art Unit 3656